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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,455	07/02/2003	Richard P. Ward	60,152-1002	5393

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HOWARD & HOWARD ATTORNEYS, P.C.
THE PINEHURST OFFICE CENTER, SUITE #101
39400 WOODWARD AVENUE
BLOOMFIELD HILLS, MI 48304-5151

EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,455

Applicant(s)

WARD ET AL.

Examiner

Flemming Saether

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4, 5, 7 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restriction

Claims 4, 5, 7 and 18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6, 8-17 and 21-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending Application No. 10/439,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because, again, the claimed features in the instant application are broadly defined to where they are found in the claims of the parent application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 9 and 17, the characterizing of the bottom wall as "generally trapezoidal" is incorrect since a trapezoid requires straight sides whereas in the instant invention, the inner and outer walls are curved which is contrary to the definition of "trapezoidal".

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The ribs being inclined from the inner side wall to the bottom wall is considered new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusser (US 3,253,631) in view of Palmer (US 6,220,804). Reusser discloses a self attaching nut (1) comprising a central portion (7) and a flange (9) with a groove (10) formed therebetween. The groove having a "substantially" perpendicular bottom wall and an inclined inner side wall (at 12) forming a restricted opening and including a plurality of spaced radial ribs (13) forming a trapezoidal shape therebetween, each with an inclined planer top surface, extending integral with an outer side wall to a location beyond a mid portion of the groove and spaced "adjacent" to the inner side wall. Reusser discloses the ribs to have opposed planer side faces (15) but, does not disclose the side faces to be perpendicular with the bottom surface of the groove. Palmer discloses a similar type nut and teaches to have the side faces of the ribs (at 43) formed perpendicular to a bottom of the groove. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the side faces of the ribs in Reusser as perpendicular to a bottom surface of the groove as disclosed in Palmer in order to provide improved resistance to rotation. Indeed Palmer describes the perpendicular orientation as being preferred (column 6, lines 29-31).

Claims 1-3, 6, 8, 11-17 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Müller in view of Reusser and further in view of Palmer. Müller discloses a self attaching nut (10) having a pilot portion (132) and a flange (142) with a groove (118) formed therebetween. The groove includes a perpendicular bottom wall along with inner and outer walls (not labeled) inclined inwardly forming a restricted opening to the groove (see Fig. 2) and including a plurality of circumferentially spaced ribs (164) integral with the outer side wall and having a top spaced from the bottom wall of the groove below the height of the flange (see Fig. 1). Müller does not disclose the shape of the ribs as claimed. Reusser discloses a similar type nut wherein a plurality of spaced radial ribs (13), each with an inclined planar top surface, extend integral with an outer side wall to a location beyond a mid portion of the groove and spaced "adjacent" to the inner side wall. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the ribs of Müller of a shape as disclosed in Reusser to provide improved resistance against rotation. Müller is not specific as to the shape of the ribs, other than being triangular in side view, and Reusser provides a rib specifically designed to prevent rotation which would have been recognized in Müller to provide improved resistance to rotation. Müller as modified by Reusser discloses the ribs to have opposed planar side faces (15) but, does not disclose the side faces to be perpendicular with the bottom surface of the groove. Palmer discloses a similar type nut and teaches to have the side faces of the ribs (at 43) formed perpendicular to a bottom of the groove. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the side faces of the ribs in modified Müller as

perpendicular to a bottom surface of the groove as disclosed in Palmer in order to provide still further improved resistance to rotation. In that regard, Palmer describes the perpendicular orientation as being preferred (column 6, lines 29-31).

Response to Remarks

Non-elected claims 4, 5 and 7 will be rejoined should claim 1 become allowable assuming there are indefiniteness issues as may be a result of amendment to claim 1.

The double patenting rejection over patent 6,851,904 has been obviated by the Terminal Disclaimer however the double patenting rejection over 10/429,459 has been maintained in view of the rejection not being addressed by applicant.

In regards the 112 second paragraph rejection, the claims are no longer rejected based on the meaning of "adjacent" since applicant has chosen to retain the term based on the dictionary definition that "adjacent" means "to lie near" or "not distant". As noted in the previous office action and supported by the definitions "adjacent" still has no meaning in the context of the claims since both "to lie near" and "not distant" are terms of degree and without any base or relative value there would be no limits to any of: "to lie near", "not distant" and similarly "adjacent". As noted in the above rejection, the 112 second paragraph rejection in regards to "trapezoidal" has been maintained because the inclusion of "generally" cannot change the definition of a "trapezoidal" particularly since the feature of the claims cannot ever be trapezoidal.

Applicant next addresses the rejection under 35 U.S.C. 103(a), apparently arguing that the combination would not be motivated. In response, the examiner disagrees.

Applicant addresses each of reference individually indicating that each of Müller, Reusser and Palmer lack certain features of the claims. In response, the examiner agrees however, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the discussion of the references individually, applicant notes that Müller includes rounded edges as a basis for their being no motivation for the combination. In response, the examiner is unsure of how the rounded edges would make the combination unobvious. Müller is very general in the discussion of the noses/ribs (column 8, paragraph beginning line 30) and therefore is the rounded edges would not teach away from the combination. It should be recognized that the rounded edges do not teach away for there being planer surfaces because the rounded edges would work in conjunction with the planer surface by forming rounded edges where the planer surfaces come together thus maintain the avoidance of cracks while at the same having the advantageous provided by the planer surfaces as disclosed in Reusser and Palmer.

Applicant next addresses Reusser and concludes that the "pair of diverging side walls 15" are necessary to properly direct the metal flow of the panel thus teaching

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away from any combination to make them parallel. In response, while the examiner concedes that the side walls are divergent, the examiner cannot agree that the function of the divergent side walls is for metal flow since that is simply not disclosed in Reusser. The examiner submits that the divergent side wall are likely the result of the method of manufacturing the nut by "axial -pressure cold-forming methods" (see column 2, lines 33-35) wherein divergent side wall would be easier to form. The skilled artisan would be recognized other manufacturing techniques, such as forging or cutting, to make the side walls parallel and perpendicular as disclosed to be advantageous in view of Palmer.

Applicant next argues that in Palmer the ribs between the inner and outer side walls thus is not spaced form the inner side wall. In response, the examiner agrees but, Palmer is not relied upon to teach the feature of the rib spaced form the inner wall since that feature is already disclosed in both Müller and Reusser.

In conclusion, the examiner maintains that the combination is properly motivated and that the combination would not be contrary to the teaching of the individual reference for the reasons as set forth in the above rejections and in responding to applicant's remarks.

Conclusion

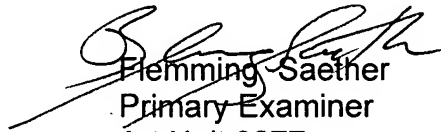
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Flemming Saether
Primary Examiner
Art Unit 3677